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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: :
Mario POLEGATO MORRETTI : GROUP: 3728
SERIAL NO: 09/765,605 : EXAMINER: Stashick, A.
FILED: January 22, 2001 :
FOR: WATERPROOFED VAPOR-PERMEABLE
SOLE FOR SHOES

REPLY BRIEF UNDER 37 CFR 1.193

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

TECHNOLOGY CENTER R3700

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Reply
Brief
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SIR:

In reply to the Examiner's answer dated April 15, 2003, Appellant notes the following:

Applicant herein advises that the real party in interest in the above-identified application has changed to GEOX S.P.A. of Frazione Biadene, Italy.

The Examiner has stated that various portions of the arguments in the Appeal Brief are unclear or are not understood (see section 11 of the Examiner's Answer). Appellant believes that the arguments contained in the Appeal Brief are clear. Specifically, it is clear that the Examiner has failed to disclose any teaching which would have motivated those skilled in the art to have replaced the rubber sole 5 of Dassler with leather. The Examiner has relied upon Squadroni for this purpose, and has alleged that the arguments of the Appeal Brief are unclear in view of column 2, lines 66-67 of Squadroni ("preferably made of leather or rubber, both preferably made

of rubber”). While Appellant believes that the arguments in the Appeal Brief are clear, further explanation is given below:

To further clarify Appellant’s position, the noted portion of Squadroni does not provide a motivation for those skilled in the art to have replaced a rubber sole to be ventilated in Dassler with a leather sole. It is true that this portion of Squadroni discloses a sole to be ventilated which may be formed of rubber or leather. Therefore, if all of the elements of the claims were present in Squadroni, such that the claims were anticipated by Squadroni under 35 USC 102, the inquiry would need go no farther. However, Squadroni is simply being applied as a teaching reference under 35 USC 103 to suggest a modification of Dassler. As such, all of the teachings of Squadroni must be considered, including those teaching against the invention MPEP § 2141.02. Here, while Squadroni discloses that a sole could be made of rubber or leather, it further states that the sole is “most preferably rubber,” i.e., rubber is preferable to leather as the material of a sole to be ventilated.

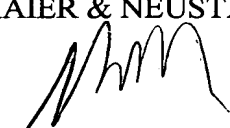
This would most certainly not motivate those skilled in the art to replace a rubber sole (Dassler) with a leather sole. Since rubber is taught by Squadroni to be preferable to leather as the material for a ventilated sole, it would be contrary to the clear suggestion of this reference for one skilled in the art to replace the (preferable) rubber sole of Dassler with a (less preferable) leather sole. Thus, Squadroni cannot provide the necessary motivation for such a modification.

Appellant had pointed out in the Appeal Brief that Polegato also cannot provide the necessary teaching that the sole of Dassler should be made from leather. The Examiner has replied that “this argument is not currently understood, as Polegato was not used for this teaching.” Thus, the Examiner is evidently in agreement with appellant that Polegato does not provide this teaching. Of course, the hard plastic ski

boot of Ohashi would also be incapable of teaching the use of a leather sole. Thus, no combination of the cited references teaches or suggests substituting a leather sole for the rubber sole of Dassler.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Registration No. 25,599
Attorney of Record
Robert T. Pous
Registration No. 29,099



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Tel. (703) 413-3000
Fax. (703) 413-2220

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